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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,169	04/18/2001	Bernard Dujon	3495.0111-12	6768

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FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,169

Applicant(s)

DUJON ET AL.

Examiner

Charles L. Patterson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The disclosure is objected to because of the following informalities:

The amendment to the first paragraph does not contain the information that 09/196,131 and 09/417,226 have now issued as U.S. Patents. The examiner would have entered this information into the specification and initialed it, but there was insufficient room to do this because the instant amendment is single spaced.

Appropriate correction is required.

Claims 27, 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is indefinite in the recitation of "having at least one HO endonuclease or Group I intron encoded endonuclease recognition site inserted at a unique location in a chromosome" on lines 3-5. It is unclear from this recitation whether an HO endonuclease or an HO endonuclease recognition site is inserted. The claim is also indefinite in the recitation of "said endonuclease" on lines 6, 12 and 13. In view of the lack of clarity of the recitation on lines 3-5 it is unclear whether the HO endonuclease alone or both this endonuclease and the Group I endonuclease are being referred to.

Claim 27 also is indefinite in that it lacks antecedent basis for "the chromosomal DNA" in line 9.

Claim 33 is indefinite in that it lacks antecedent basis for "said endonuclease site" on line 1.

Claim 34 is indefinite in that it lacks antecedent basis for "said endonuclease recognition site". Since it is unclear whether the recitation of "said endonuclease site" in claim 32 is meant to be "said endonuclease recognition site", the reference to it in this claim is indefinite.

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Claim 34 is also indefinite in the recitation of "Class I I-endonuclease sites, ...Class V I-endonuclease sites". It is not known what these particular classes of enzymes are, nor does the specification apparently teach these classes.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification does not teach how to use HO endonucleases or Group I intron encoded endonucleases to perform the genetic recombination of the instant claims. The specification does not even characterize exactly what these groups of enzymes are, what their characteristics are or which enzymes are members of these groups. In the last sentences of the first paragraph on page 4 it is stated that "[t]he repair events induced by I-SceI are identical to those initiated by HO", but this does not teach exactly what the characteristics of the enzymes are. Figure 6 is stated to show "Group I intron encoding endonucleases and related endonucleases" (page 7), but neither the figure description nor the figure itself points out which are Group I intron encoding endonucleases and which are related endonucleases. [In this regard, it is not clear from this recitation or any other part of the specification whether I-SceI is a member of either HO endonucleases or Group I encoded endonucleases, but if it shown that it is a member then an obvious-


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type double patenting rejection would be proper over claims 19-29 of U.S. Patent 5,962,327 and claims 1-7 of U.S. Patent 6,238,924.] The specification does not teach that any or all members of these two groups of enzymes can be used for the method of the instant claims, absent convincing proof to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
June 7, 2002